

When an applicant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the applicant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence.

The patent statutes, the MPEP, and the Federal Circuit opinions discussing patentability are replete with references to considering the claimed invention as a whole and the prior art as a whole. Similarly, there are many Federal Circuit opinions requiring that the claims and the prior art be considered from the viewpoint of one of ordinary skill in the art. Finally, it is also required that the Examiner not dissect the claim into discrete elements to be analyzed in isolation; e.g. see *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 309 (Fed. Cir. 1983).

Applicant has provided evidence of record showing what one of ordinary skill in the art considers a multiplex circuit and what one of ordinary skill in the art considers a non-linear processor. The Examiner's position that the non-linear processors of the prior art "performs the function of the claimed 'multiplex circuit'" is completely at odds with the patent statutes, the MPEP, and the decisions of the Federal Circuit because

- (1) the interpretation is not based upon the words of the prior art;
- (2) the interpretation is at odds with the understanding of those of ordinary skill in the art as shown by the evidence of record;
- (3) the interpretation is a piecemeal analysis of the claim;
- (4) the interpretation is an erroneous analysis of the claim – applicant is claiming a device, not a function;
- (5) the interpretation is technically incorrect; and
- (6) the interpretation is contrary to the express disclosure of the prior art.

The Examiner is again requested to comply with all relevant patent statutes, court decisions, and sections of the MPEP.

Claims 1 and 8 were rejected as anticipated by Genter. In support of the rejection, the Examiner asserts "non-linear processor (36a-p)." **Contrary to the**

**Examiner's denial on page 10 of the Office Action**, the Examiner mischaracterizes the Genter patent by using the singular, as though a single element were involved. What the Genter patent discloses is a **plurality** of non-linear processors, which are referred to in the **plural** in the patent and which operate **independently**. See Genter patent, column 2, line 36, "independent echo cancellation", column 2, line 47, "on an independent basis", column 2, lines 55-56, "The level ... is independently controlled", for example. In the Examiner's view, a multiplex circuit has a plurality of independently operating parallel branches. It is submitted that such is **contrary** to the view of one of ordinary skill in the art, as shown by the ignored evidence of record. In fact, it is the antithesis of a multiplex circuit, in which a plurality inputs are coupled to outputs in a coordinated manner, not *ad hoc* as in the Genter patent. Alternatively, if the Examiner is asserting that a single non-linear processor performs the function of a multiplex circuit, he is requested to substantiate such an interpretation with written evidence from the prior art.

Claim 8 recites "wherein each channel includes a plurality of band pass filters." The Genter patent does not even anticipate the **preamble** of claim 8.

The Examiner's assertion that the Genter patent discloses non-linear processors "in each path" **mischaracterizes** the prior art and **mischaracterizes** claim 8. No "path" is recited in claim 8. Claim 8 recites two channels. The Examiner **further mischaracterizes** the prior art because there are no non-linear processors in a channel from a line input to a speaker. There is no microphone disclosed in the Genter patent. There is no line input disclosed in the Genter patent. The Genter patent relates to a telephone network between two stations, not apparatus "in a telephone" as recited; see column 3, lines 29ff., of the Genter patent.

The controller recited in claim 8 is not remotely disclosed or suggested by the Genter patent. The Examiner asserts that the "attenuator factor controller reads on the claimed 'controller'". This is not a proper examination. The question is whether or not a claim reads on the prior art, not whether or not the prior art somehow reads on a claim.

The claimed controller initially couples "complementary subsets of filters to the respective outputs." This recitation is ignored in the Examiner's sweeping conclusion of anticipation. It is respectfully submitted that ignoring claim language is not a proper examination. "*When evaluating the scope of a claim, every limitation in the*

*claim must be considered.*" See, e.g., *In re Ochiai*, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).


Claim 11 was rejected as unpatentable over Genter in view of McCaslin et al. The Genter patent is discussed above. Nowhere is it disclosed in the McCaslin et al. patent that a signal be attenuated if the duration of the signal exceeds a threshold.

The Examiner refers to column 25, lines 18–38. As described therein, an Infinite Impulse Response (IIR) filter has two separately programmed responses, slow and fast. As subsequently described, lines 39 ff, the filter response is determined by data stored in certain memory locations. The choice of which data to select is determined in block 508 (FIG. 22) in accordance with the near end and far end power estimates; lines 61–67. In other words, the choice is based upon **amplitude**, not time. There is no disclosure of any apparatus for attenuating the filtered output signal if the **duration** of the filtered output signal exceeds a predetermined threshold.

The assertion of inherency by the Examiner reverses cause and effect ("providing attenuation is also an indication of the duration of the signal"). Assuming *arguendo* that the Examiner's comments to that point are correct, what is claimed is not that attenuation indicates duration but that duration triggers attenuation. The claimed cause and effect are not remotely disclosed or suggested by the McCaslin et al. patent.

In view of the foregoing remarks, it is respectfully submitted that claims 1, 2, and 5–12 are in condition for allowance and a Notice to that effect is respectfully requested.

Respectfully submitted,



Paul F. Wille

Reg. No. 25,274

Attorney for Applicant